

Attorney Docket No.: 6200.200-US
Express Mail Label No.: EV 246877165 US

Remarks

In the previous Office action, the Examiner rejected the now cancelled claims in view of Nguyen et al and Current. The presently pending claims are not obvious or anticipated by the documents cited by the Examiner in the previous Office Action. While Current shows a needle magazine for sowing needles that has radial cavities and Nguyen shows a pen needle magazine in which cavities are arranged along the circumference of a circular magazine in a non-radial fashion. Neither references, taken alone or in combination teaches a tool for attaching a needle to an injection device wherein the tool is rotated 360 and the injection device is rotated 360 and neither alone, or in combination suggests that such a tool would provide increased leverage. There mere fact that the orientation of Current might be combinable with the magazine of Nguyen, does not render the claims obvious. Here the references when read together do not teaches that it would be desirable to develop a wrench or tool that assist in mounting pen needles on injection devices. Moreover, the only motivation to combine the references is the unexpected result that the applicant's have found that changing the orientation of the cavity results in increased leverage. Of course, such hindsight reconstruction is not permissible during examination.

Unlike In re Japikse, 86 USPQ 70 (CCPA 1950), which held that the shifting of position of a starting switch was unpatentable because it did not modify operation, the radial alignment of the cavities here greatly effects operation and provides much of the benefit of the present invention. As discussed above, this configuration enables the magazine to be used as a tool that provides greater leverage in securing the pen needle to an injection device and allows the tool and device to each be rotated 360 degrees instead of rotating the device 720 degrees, as is done in the prior art. In fact, the motivation to align the cavities radially comes, in large part, from the applicant's discovery that this alignment provides a functional and operational advantage. Of course, applicants discovery cannot be the basis for a rejection.

Finally, Applicants respectfully note that it is well-settle that mere fact that a worker of ordinary skill could rearrange the parts of a reference is not sufficient to support obviousness. The prior art must provide the motivation for the rearrangement. See Ex Parte Chicago Rawhide 223 USPQ 351 (Bd Pat App. & Inter. 1984). And the applicant's own disclosure, which here demonstrates the advantages of the re-alignment, cannot be the basis for the motivation to combine.

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Conclusion

In view of the above, Applicants respectfully submit that all claims are in condition for allowance and the typographical errors in the specification have been addressed. Reconsideration of the pending application is kindly requested. The Commissioner is hereby authorized to charge any fees in connection with this application, including any fees for extensions of time, and to credit any overpayments to Deposit Account No. 14-1447.

The Examiner should feel free to contact the Applicants attorney by telephone if there are any questions concerning this amendment or application.

Respectfully submitted,

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Use the following customer number for all correspondence regarding this application.

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